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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,065	12/19/2001	Adam Wayne Mehlberg	2001-067-TAP	9460
7590 04/19/2004			EXAMINER	
Wayne P. Bailey Storage Technology Corporation One StorageTek Drive Louisville, CO 80028-4309			KIM, AHSHIK	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,065

Applicant(s)

MEHLBERG ET AL.

Examiner

Ahshik Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on January 7, 2004. Without amending
5 any claims, Applicant traversed various rejections made in previous Office Action (mailed to
Applicant on October 7, 2003). Currently, claims 1-34 remain for examination.

Drawings

2. This application has been filed with informal drawings, which are acceptable for
10 examination purposes only. Formal drawings will be required in response to this Office Action
or when the application is allowed

Claim Objections

3. Claims 23, 26, and 29 are objected to because of the following informalities:

15 Re claims 23, 26 and 29, although Examiner knows what Applicant means by
“translating a/the robot” the phrase should be rephrased/reworded, since a/the robot is
dictated by the information decoded from the barcode. Robot is not translated in a direction as
recited in these claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, line 3: "an attenuation surface affixed to the barcode scanner," would be incomprehensible to implement in that the attenuation surface reflect lights from a scanner illumination source (see claim 4). Claim 15 is rejected on the same ground.

6. Claims 2-10 are rejected under U.S.C. 112, second paragraph as being dependent claims of claim 1.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12-14, 16, 20-23, 26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rockwell et al. (US 6,138,909, "Rockwell" hereinafter).

Re claims 12, 14, 16, 20, 22, 23, 26, and 29, Rockwell teaches a robot (see figure 1; col. 1, lines 26+) comprising a gripper 22, a barcode scanner 26 providing a scan path affixed to the robot (col. 2, lines 35+), wherein the positional parameters are retrieved from the barcode (col. 3, lines 35+).

Re claims 13 and 21, as shown in figure 1, scanning direction is horizontal and the robot/gripper can move vertically and horizontally if multiple storage racks are used (col. 2, lines 48+).

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Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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11. Claims 17-19, 24, 25, 27, 28, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rockwell et al. (US 6,138,909).

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Claims 17-19, the material used in manufacturing the storage rack 18 can be used to make the rack comprising sharp edges – In fact, border area of each tray compartment 20 create sharp edges. Although Rockwell does not explicitly suggest that the surface is beveled, such

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feature is a design consideration. One ordinary skill in the art would choose to design the surface however he/she wants as long as the barcode can be applied and functions as intended.

Re claims 24, 25, 27, 28, and 30-34, as shown in figure 3, the robot retrieves/deposits a data cartridge relying on positioning the device according to offset value 44, and 45 from the (col. 3, lines 35+). Location of the left edge 46 is stored along with the barcode information (col. 3, lines 49+). Although not explicitly suggested, it is obvious to one ordinary skill in the art to store location of right edge, or calculate center/mid point using locations of right and left edges.

Additional Remarks

12. Re claims 1-10, and 15, the lack of an art rejection with this Office action is not an indication of allowable subject matter (i.e., even though claims 1-10, 15 are rewritten or amended to overcome the rejection under 35 U.S.C. 112 in paragraphs 5 and 6 above). The disclosure/claimed language is such that it is impractical to conduct a reasonable search of the prior art by the Examiner.

13. Examiner respectfully requests the Applicant to point out in the specification where “attenuation surface” is disclosed in a manner that particularly point out and distinctly claim the subject matter. All Examiner could find regarding “attenuation surface” is in the summary of the invention section (line 8) where the attenuation surface is referred in a manner that any surface would qualify as an attenuation surface.

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Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Carmichael et al. (US 5,303,034); Kishi et al. (US 5,426,581); McFadin (US 5,418,732); Ostwald (US 6,386,116); Ostwald et al. (US 6,327,519); Schmidtke et al. (US 6,664,525) disclose data storage device and robotic system for manipulating the storage devices. Applicant is respectfully suggested to carefully review these references.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
April 5, 2004